REMARKS

Claims 2 – 18 and 21 – 25, 27 - 34 are pending. Claims 1, 19, 20 and 26 are canceled. No new matter has been introduced by this amendment into the specification and/or claims. The Applicant appreciates the confirmation that claims 2 – 6[1], 10 – 18 and 21 – 24 are allowed. There are only a few remaining issues which the Applicant submits are now clearly resolved by the present Amendment and Response. In particular:

- the § 112 rejection of claims 7, 8, 9 is addressed through the explanation and argument below;
- the § 103 rejection of claims 8, 9, 25 – 34 based on Hastings (6,584,450) taken with Elston (6,055,505) is addressed through traverse, argument and/or amendment as noted below.

As can be seen below the only substantive amendments are to claims 8 and 25, and these are not believed to require any additional search effort (since they are based on points already discussed on the record) and are believed to place the case in better condition for allowance and/or appeal.

Response to § 112 rejections for claims 7, 8 and 9

Claim 7 has been rejected by the Examiner based on his concern dealing with the term "trigger event" as used in such claim. This rejection is traversed for the following reasons.

First, claim 7 specifically recites that there is a "…set of queue replenishment control rules." These rules, as the claim further recites, permit the computer to determine if the composition of the subscriber's rental queue should be altered. The claim then states that part of these rules "…include a trigger event to be used in determining when said subscriber rental queue should be modified, and said trigger event is based on a quantity of playable media items remaining in the subscriber rental queue."

Applicant submits that the meaning and scope of "trigger event" is well set out in

[1] While the Office Action states on page 1 that claim 7 is allowed, the Examiner has since indicated that this was an error and that page 2 contains the appropriate status (rejected) for this claim.

this claim, along with its relationship to the aforementioned queue replenishment control rules. The trigger event is merely part of these rules, which, as the claim specifies, are "…authorized by the subscriber." The disclosure further explains extensively with respect to FIG. 2, and particularly area 220 of the interface shown therein what the trigger event refers to:

> Thus in a second preference display area 220, a so-called queue trigger threshold question is first posed to the subscriber. In other words, "when" should the queue monitoring logic review Subscriber Selection Queue 110? As seen in this area of interface 200, the subscriber is given four threshold options, including generally the following: (1) when the Subscriber Selection Queue 110 becomes completely empty (i.e., as a result of moving the last selection into Titles Out Queue 106); (2) when the number of remaining titles in Subscriber Selection Queue 110 falls below a certain number (selectable by the user) of movies left; (3) when a desirable selection is available at the service provider (as determined by certain auto-recommend logic described herein); (4) at certain predetermined (selectable by the user) time intervals – i.e., every day, every week, etc. …" *See* page 11 (emphasis added)

In the case of claim 7, the language very clearly spells out that the "trigger event" is "…based on a quantity of playable media items remaining in the subscriber rental queue…" In other words, one example would be, as the specification points out, that the subscriber could request (as part of the queue replenishment control rules) that his/her queue be considered for a composition change when the number of titles falls below a certain number (FIG. 2 shows an example of 2 movies left for example).

Similarly, in claims 8/9 the trigger event is based on a determination "..that an additional playable media item should be added to the subscriber rental queue as a recommended playable media item." Again, this is tied back to the queue replenishment control rules authorized by the subscriber. The subscriber can specifically elect to have the recommender system be part of the decision making of when a composition of the queue should be considered for alteration.

Consequently the Applicant submits that the aforementioned "trigger event" is well defined in the specification and its relationship to the other elements of the claim is also set out quite clearly – as part of the queue replenishment control rules. For this reason the rejection under §112 (2) for claims 7, 8 and 9 is respectfully traversed.

Rejection of Claims 8, 9, 25 – 34 in light of Hastings (6584450) and Elston (6055505)

Independent claim 8 has been amended in minor ways to further clarify the distinction over the Hastings and Elston combination. While Hastings discloses giving recommendations,[2] it does not do so by considering the composition of the subscriber's rental queue. The Elston reference does not address this deficiency in Hastings.

Moreover Elston discloses notifications in an entirely different context unrelated to the present invention. While such system "can" be used in other environments, as the Examiner notes, the simple fact is that at the time of the present invention, the practice was exactly the opposite. Thus, the relevance of prior art disclosing financial account low balance notifications is marginal, and that is what Applicant pointed out in the last response. At the time of the present invention's filing, the operators of commercial online DVD rental systems required their subscribers to maintain – on their own time – a sufficient supply of media items to avoid delays in shipping titles. They did not offer (and were not motivated) to perform this task on behalf of the subscriber for the plain reason that at such time it was perceived as economically disadvantageous. Thus, a person skilled in the art would be taught away from the type of method proposed in the present claims.

Accordingly Applicant submits that this is another reason why this claim should be allowable.

For independent claim 9: no changes are proposed. The Applicant discussed this claim with the Examiner before and pointed out that Hastings does not teach or suggest that the "recommended" playable media item is designated as the next to be delivered to the subscriber. In other words, it is automatically bumped to the top of the queue. This, again, is a desirable feature which ensures that more pertinent/interesting subject matter is automatically elevated in status for the subscriber and delivered with a higher priority than other titles which may have become stale or be less interesting. The sections noted by the Examiner in Hastings only refers to the general sequencing of movies and make no mention or suggestion of the specific feature set out in claim 9.

Independent claim 25: Applicant disagrees with the characterization of Hastings; nonetheless the claim has been amended effectively to include the limitations of claim 26 (now canceled) and to clarify that the notification includes:

> .... both an identification of an additional playable media item which is being added to the subscriber rental queue at the end of a first time period as well as selectable feedback options allowing automatic removal of such additional playable media item without further action by the subscriber;
>
> further comprising adding said additional playable media item to said subscriber rental queue unless removed by the subscriber within said time period specified in said notification.

The Examiner should take note that the claim is amended to further clarify that the "notification" allows for the subscriber to automatically remove the title without requiring further action, hence differentiating over the scheme taught in Hastings in which the subscriber must manually visit the website to remove the movie from the queue. Nor does Hastings make any mention of any particular time period to take action. Accordingly this claim (and claims 27 – 29 depending therefrom) is believed to be allowable over the references.

Response for claims 30 - 34

No changes are proposed for claim 30. The Examiner's rejection appears in part to be due to a mis-parsing of limitation (f) of the claim; this specifically states "…. interacting with the subscriber using embedded uniform resource links (URLs) or an electronic response field **in said** electronic notification…." (emphasis added) This language makes it clear that the URL is embedded and thus part of the electronic notification. The reference to Hastings, as the Examiner acknowledges, contains no such capability. See page 4 Office Action discussion about "response field" portion of the electronic notification. Hence this claim should be allowable for this reason.

(..continued)

[2] As a side note, while Hastings specifies that customers get certain titles fulfilling certain parameters, it does not in fact state that a recommender system is used for selecting from a set of movies which meet such criteria.

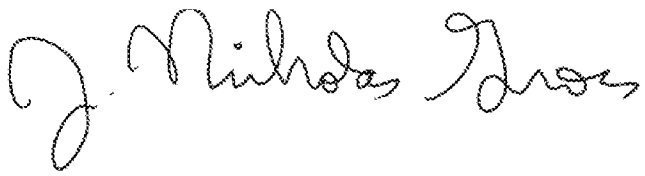
Moreover, as noted above, the objective evidence demonstrates that Elston is inapplicable from an obviousness perspective, because the actual state of notification technology in this field of art illustrates the long felt need for a solution of the type provided in the present invention. Thus claim 30 and dependent claims 31 – 34 should be allowable.

Conclusion

Applicant has addressed all the outstanding issues presented in the most recent Office Action. Only minor changes are proposed which should place the case in better condition for allowance and/or appeal.

Should the Examiner wish to discuss anything related to this case in person, feel free to contact the undersigned at any convenient time.

Respectfully submitted,



J. Nicholas Gross
Registration No. 34,175
Attorney for Applicant(s)

January 29, 2007
2030 Addison Street
Suite 610
Berkeley, CA 94704
Tel. (510) 540-6300
Fax (510) 540-6315